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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/937,897

09/28/2001

Oliver Lemmer

00475.00004

5702

7590

05/17/2006

EXAMINER

TURNER, ARCHENE A

Banner & Witcoff

Eleventh Floor

1001 G Street NW

Washington, DC 20001-4597

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,897

Applicant(s)

LEMMER ET AL.

Examiner

Archene Turner

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Vohra et al (6,183,818).

Vohra et al discloses the claimed nano crystalline carbon coating on a tool (abstract) within the claimed thickness (column 7, line 37).

3. Claims 21,29,32,35, are rejected under 35 U.S.C. 102(e) as being anticipated by Overstreet et al (5,954,147).

Applicant's arguments filed 2/28/06 have been fully considered but they are not persuasive. The applicant is arguing that the tool is used for machining which is not considered persuasive since that in future intended use of the product and thus the rejected product claims stand. The applicant is also arguing that the product is made by a different method, which is not found persuasive since the applicant is reminded that an invention defined in a product by process claim is a product, not a process (*In re Bridford*, 357 F. 2d 679, 149 USPQ (CCPA 1966)).

When the prior art discloses a product which reasonably appears to be either

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identical with or only slightly different than a product in a product by process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the product differs in kind from those of the prior art (*In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974)). This burden is NOT discharged solely because the product was derived from a process known to the prior art (*In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974)). Thus the rejection stands.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22-28,30,31,36,37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Overstreet et al (5,954,147).

Applicant's arguments filed 2/28/06 have been fully considered but they are not persuasive. The applicant is arguing that the tool is used for machining which is not considered persuasive since that in future intended use of the product and thus the rejected product claims stand. The applicant is also arguing that the product is made by a different method, which is not found persuasive since the

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applicant is reminded that an invention defined in a product by process claim is a product, not a process (In re Brideford, 357 F. 2d 679, 149 USPQ (CCPA 1966)).

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product in a product by process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the product differs in kind from those of the prior art (In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); In re Fessman, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974)). This burden is NOT discharged solely because the product was derived from a process known to the prior art (In re Fessman, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974)). Thus the rejection stands.

6. Claims 21-28, 32-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vohra et al (as before) in view of Overstreet et al (as before).

Vohra et al discloses the invention as claimed except for the additional layers to attach the nano-crystalline coating.

Overstreet et al discloses that a nano crystalline carbon coating may be attached to a tool by additional layers.

Thus it would have been obvious to one of ordinary skill in the art to provide for the additional claimed layers to attach a nano crystalline carbon coating and apply them through a CVD method, since diamond containing

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coatings are known to be produced by CVD and Overstreet et al shows that additional claimed layers can be used to attach a nano crystalline coating.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Archene Turner whose new telephone number is (571) 272-1545. The examiner can normally be reached on Monday, Wednesday through Friday from 10:30 am. to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number

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for the organization where this application or proceeding is assigned is 703-872-9306.

Please remember to include on the fax, the art unit 1775, serial number and Examiner's name.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'A. A. Turner', with a long horizontal flourish extending to the right.

A. A. Turner
Primary Examiner
Group 1700

aat